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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/749,601
Filing Date: December 31, 2003
Appellant(s): HOOPMAN, TIMOTHY L.

William R. Berggren
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 01/07/08 appealing from the Office action mailed 01/23/06.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102 or § 103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-17 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Stauff.

The patent to Stauff discloses a pack of playing cards having many of the features recited in claims 1-17. Note, Stauff's first indicia (numerical values) in the primary corners and secondary corners are clearly **horizontally aligned** with the second indicia (suit) in a region bordering the top edge and the bottom edge. In Stauff's playing cards, the judicious placement of the second indicia (suit) in the first position being horizontally aligned with the right-reading first indicia in a region bordering the top

edge, and the judicious placement of second indicia (suit) in the second position being horizontally aligned with the upside-down reading first indicia in a region bordering the bottom edge, makes Stauff's playing cards **capable** of lessening the precision of vertical columnar alignment and columnar length over that obtainable with previously known pack of playing cards.

Concerning claim 1, the recitation "a previously known pack of playing cards" is a **relative term** that is open to **broad interpretation**. Any pack of playing cards, e.g. (Stauff's playing cards, Uno playing cards, etc.) may be called "a previously known pack of playing cards".

In regard to claims, 2 and 9, the Examiner agrees with the Applicant's argument that Stauff's second indicia (suit) in the first position in the region bordering the top edge, and the second indicia (suit) in the second position in the region bordering the bottom edge, are both located at a point **midway** between primary and secondary corners. However, the Examiner takes the position that the term "**horizontally proximate**" is a **relative term** that is open to **broad interpretation**. Thus, Stauff's second indicia (suit) in the first position in the region bordering the top edge, and in the second position in the region bordering the bottom edge, are both located **broadly** horizontally proximate the right-reading first indicia in the region bordering the top edge, and the upside-down-reading first indicia in the region bordering the bottom edge, respectively.

Concerning claims 7 and 11, Stauff's playing cards in Figs. 1 – 9 clearly disclose second indicia (diamond suit), inside the regions bordered by the edges, as being

enlarged compared to the second indicia (diamond suit) located outside the region near the primary corners of the playing cards.

The only differences between the claimed invention, and Stauff's playing cards are:

1) In claims 2 and 9, the second indicia (suit) in the first position having a **right-reading orientation** in the region bordering the top edge, the second indicia (suit) in the second position having an **upside-down-reading orientation** in the region bordering the bottom edge. In Stauff's playing cards, the second indicia (suit) reading orientations are reversed, see Figs. 12 – 23.

2) In claims 5 and 16, the second indicia (suit) in the **seventh** position being proximate to and below the right-reading first indicia in the secondary corner in the region bordering the right edge, and the second indicia in the **eight** position being proximate to and above the upside-down-reading first indicia in the secondary corner in the region bordering the left edge. Stauff's playing cards do not have second indicia (suit) in the seventh and eight positions.

3) In claim 8, the picture on the Face Card has an upper half in a right reading orientation and similar lower half in an upside-down reading orientation such that the graphic looks similar whether seen right-side up or upside down. The Face Cards in Stauff's playing cards, Figs. 12 – 23 do not have this feature.

These differences only reside in the meaning and information conveyed by **printed matter**. Such differences are considered unpatentable, *Ex parte Breslow*, 192 USPQ 431.

Furthermore or in the alternative, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Stauff's playing cards by positioning the second indicia (suit) in the first position in a right-reading orientation in the top edge, positioning the second indicia (suit) in the second position in an upside-down-reading orientation in the bottom edge, providing second indicia (suit) in the seventh and eighth positions, and replacing the pictures in Stauff's Face Cards with pictures having an upper half in a right reading orientation and similar lower half in an upside-down reading orientation such that the graphic looks similar whether seen right-side up or upside down. These modifications would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate, it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack*, 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of playing card does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is **no** novel or unobvious functional relationship between the claimed printed matter e.g. (positioning of the first indicia and second indicia, right-reading orientation, upside-down-reading orientation, position of second indicia on seventh and eighth positions, pictures in Face Cards having an upper half in a right reading orientation and similar lower half in an upside-down reading orientation) and the substrate e.g. (playing card surface) which is required for patentability.

(10) Response to Argument

The Applicant has argued that Stauff being **capable** of permitting less precise and shorter columnar arrangements is insufficient for a rejection under 35 U.S.C. 102(b) or under 103. Stauff is a design patent with no suggestion of changing the claimed designs to render the upper second indicia in a right-reading orientation or of using numbers as second indicia and suits as first indicia, an embodiment of the claimed invention. Stauff may be suitable for vertical row alignment but not columnar alignment.

The Examiner takes the position that the statement “judicious placement to lessen both precision of vertical columnar alignment and columnar length over that of obtainable with previously known pack of playing cards” is a statement of intended use. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is **capable** of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963). In this case, the placement of the first indicia (numerical value) and second indicia (suit) along the top edge and bottom edge of Stauff’s cards, makes Stauff’s cards **capable** of lessening both precision

of vertical columnar alignment and columnar length over that of obtainable with previously known pack of playing cards.

The Applicant also disagrees with the Examiner's broad interpretation of "horizontally proximate", and how the Examiner used this interpretation to allow Stauff to anticipate the invention or make it obvious. The Applicant argues that claim language is primarily read in light of the specification. The specification uses proximate and adjacent interchangeably, and the specification refers to second indicia in various embodiments claimed specifically in claims 2-7 as being horizontally "adjacent" to the first indicia on page 9, line 14.....

The Examiner maintains his position that Stauff's second indicia (suit) is horizontally proximate to the first indicia (numerical value) in a region bordering the top edge of Stauff's cards, and in a region bordering the bottom edge of Stauff's cards. The Examiner also takes the position that Stauff's second indicia (suit) and the location of the second suit along the top edge of Stauff's card **performs the same function** as the claimed second indicia (suit) being in a region bordering the top edge. That function being the lessening the precision of vertical columnar alignment and columnar length over that obtainable with previously known pack of playing cards. Determining exactly where the second indicia is positioned (near the top left corner adjacent the first indicia, at the center area, etc.) on the top edge of Stauff's cards, does **not** change the function of the second indicia.

In regard to the Applicant's argument concerning printed matter, the Applicant has argued that the Applicant's invention has a new and unobvious functional

relationship between the printed elements and the substrate. That combination permits columns of shorter length and columns with less precise columnar alignment than obtained with known decks of playing cards.

The case of *In re Gulack*, 217 USPQ401, involved printed matter in a Section 103 rejection. *Gulack's* invention comprised a circular band (substrate) and a sequence of numbers derived from a mathematical algorithm (printed matter) printed on the band. The patent to Wittcoff, which was used by the Examiner to reject *Gulack's* claims, comprised a circular band (substrate) and informational data such as addition, subtraction, historical dates, etc. (printed matter) printed on the band. The "critical question" raised in *Gulack* was "whether there exists any new and unobvious functional relationship between the printed matter and the substrate". The Court determined that Wittcoff simply exploited the band as a means of supporting and displaying informational data in an endless loop configuration, wherein the data was **not** arranged in any particular sequence. On the other hand, the Court found that *Gulack's* particular sequence of digits, which has a "cyclic nature", and the positioning of this sequence of digits on the band **exploited the endless nature of the band**. This exploitation provided a new and unobvious functional relationship between the printed matter and the substrate.

The Examiner takes the position that the Applicant's claimed judicious placement of first indicia (numerical value) and second indicia (suit) functionally relates to the Applicant's claimed cards substrate as a means of "lessening the precision of vertical columnar alignment and columnar length over that obtainable with previously

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known pack of playing cards". This functional relationship is clearly capable of being taught by Stauff above.

Therefore, the only difference between the claimed judicious placement of first indicia and second indicia on the claimed playing cards, and Stauff's placement of first indicia and second indicia on Stauff's playing cards resides in the meaning and information conveyed by printed matter and not in any structure per se. Such differences are not considered patentable differences, *Ex parte Breslow*, 192 USPQ 431.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Benjamin H. Layno/

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